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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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03/30/2001

Hernan G. Otero

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54205 7590 06/23/2009

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EXAMINER

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ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HERNAN G. OTERO,
STEVEN B. HORN and JOHN TUMILTY

Application No. 09/823,125
Technology Center 3600

Mailed: June 23, 2009

Before PAMELA S. BENNETT, *Review Team Paralegal*.
BENNETT, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on June 22, 2009. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

APPEAL BRIEF, HEADINGS

A review of the file indicates that the Appeal Brief filed April 16, 2007 does not comply with the guidelines provided in 37 C.F.R. § 41.37(c)(1)(ii) and (x) (2006) which states:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

. . . .

(ii) *Related appeals and interferences.* A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directed affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (c)(1)(x) of this section.

. . . .

(x) *Related proceedings appendix.* An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

The Appeal Brief filed April 16, 2007 is deficient because the "Related appeals and interferences" section fails to include a statement regarding the filing of an Appeal Brief in Application Number 09/773,139 (the present application is a continuation-in-part of this application).

AMENDMENT/RESPONSE

In response to the Examiner's Answer mailed February 4, 2009, appellants filed an Amendment/Response dated April 6, 2009. Page 7 of this paper requests "reopening of prosecution, withdrawal of the appeal, and reconsideration and withdrawal of the pending rejections" There is no indication on the record that the Examiner has considered the above Amendment/Response.

It is noted that a PTOL-90 was mailed on June 23, 2009 which stated that "[t]he reply brief filed on April 06, 2009 has been entered and considered." Clarification is required since no Reply Brief filed April 6, 2009 has been made of record in the application.

CONCLUSION

Accordingly, it is ORDERED that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed April 16, 2007 defective;
- 2) for notification to appellants to file a "paper" which corrects the "Related appeals and interferences" section in compliance with 37 C.F.R. § 41.37;
- 3) for consideration of any "paper" submitted by Appellants to correct the Appeal Brief;
- 4) to consider the Amendment/Response filed April 6, 2009 as required;

- 5) for clarification regarding the status of the Reply Brief filed April 6, 2009, noted in the PTOL-90 mailed June 23, 2009;
- a) if appropriate, to have a copy of the Reply Brief filed April 6, 2009 scanned into the application;
 - b) if no Reply Brief has been submitted, to vacate the PTOL-90 mailed June 23, 2009; and
- 6) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

PSB

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